

**SERIAL NO. 09/923,323****DOCKET NO. 1293.1059CIPD2****REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1, 3, 4, 9, 11, 14-17, 23, 24, 28, 29 and 31 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-31 are pending and under consideration. Reconsideration is requested.

**ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:**

Applicants request entry of this Rule 116 Response because:

- (1) it is believed that the amendment of claims 1, 3, 4, 9, 11, 14-17, 23, 24, 28, 29 and 31 puts this application into condition for allowance as suggested by the Examiner;
- (2) the amendments of claims 1, 3, 4, 9, 11, 14-17, 23, 24, 28, 29 and 31 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised as compared to claims 10, 23, and 24; and
- (3) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**OBJECTIONS TO THE CLAIMS:**

In the Office Action at page 3, the Examiner objects to claims 15 and 31 as set forth therein. In view of the amendments to claims 15 and 31 in accordance with the Examiner's suggestion, it is respectfully submitted that the outstanding objections should be resolved, and it is requested that the objection be reconsidered and withdrawn.

**SERIAL NO. 09/023,323****DOCKET NO. 1293.1059CIPD2****REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 3-6, the Examiner rejects claims 1, 3-6, 8, 11, 14, 29, and 31 under 35 U.S.C. §102(b) in view of Fukuda et al. (U.S. Patent No. 5,983,290). This rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that Fukuda et al. teaches the features as suggested in the Office Action, for at least reasons similar to why Fukuda et al. does not disclose or suggest the features of claims 10, 23, and 24 as admitted on page 12 of the Office Action, it is respectfully submitted that Fukuda et al. does not disclose or suggest "a controller to control the decoding unit so as to simultaneously decode the audio data to be played back and the catalog information corresponding to the audio data to be played back according to the catalog playback information," "wherein the catalog playback information comprises an auto presentation information table in which is stored a location of one item of the catalog information to be played back corresponding to a predetermined time according to real-time playback information of the audio data obtained by real-time playback of the audio data" as recited in claim 1.

For at least similar reasons, it is respectfully submitted that Fukuda et al. does not disclose or suggest the features of claims 4, 11, 14, and 29.

Additionally, the Examiner asserts that Fukuda et al. teaches the use of DVD-audio as recited in claim 14. However, it is respectfully submitted that, while Fukuda et al. discloses the use of an AC3 audio system used for DVDs is one of the coding systems that can be indicated by the audio data management information 111, there is no suggestion that the data storage medium uses DVD-audio as would be understood by one of ordinary skill in the art. As such, it is respectfully submitted that Fukuda et al. further does not suggest the use of DVD-audio as recited in claim 14.

For at least similar reasons, it is respectfully submitted that Fukuda et al. does not suggest, among other features, that "the catalog information being reproduced are in a title set and the DVD-audio data being reproduced is in another title set other than the title set" as recited in claim 31.

Claims 3, 5, 6, and 8 are deemed patentable due at least to their depending from corresponding claims 1 and 4.

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action at pages 6-10, the Examiner rejects claims 9, 15-22, 25-27, and 30 under 35 U.S.C. §103 in view of Fukuda et al. and Katayama (U.S. Patent No. 5,902,115). The

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rejection is respectfully traversed and reconsideration is requested.

For at least reasons similar to why Fukuda et al. does not disclose the features of claim 1, it is respectfully submitted that Fukuda et al. does not disclose or suggest, among other features, "a controller which controls playback of the catalog information according to the catalog playback information," "wherein the catalog playback information comprises an auto presentation information table in which is stored a location of one item of the catalog information to be played back corresponding to a predetermined time according to real-time playback information of the audio data obtained by real-time playback of the audio data" as recited in claim 9.

The Examiner does not rely upon Katayama as curing this deficiency. As such, even assuming arguendo that the Examiner's characterization of Katayama is correct and that there is a motivation to make the combination, it is respectfully submitted that the combination does not disclose or suggest the invention recited in claim 9.

For at least similar reasons, it is respectfully submitted that the combination does not disclose or suggest the invention recited in claim 16.

Similarly, since Katayama is not relied upon as curing the above noted deficiency of claim 14 from which claim 15 depends, it is respectfully submitted that the combination does not disclose or suggest the features of claim 15.

Claims 17-22, 25-27, and 30 are deemed patentable due at least to their depending from corresponding claims 9 and 16.

In the Office Action at pages 10-11, the Examiner rejects claims 2, 7, 12, and 13 under 35 U.S.C. §103 in view of Fukuda et al. and Moriyama et al. (U.S. Patent No. 5,889,746). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's combination is correct, the Examiner does not rely upon Moriyama et al. as curing the above noted deficiency of Fukuda et al. as applied to claims 1, 4, and 11, from which claims 2, 7, 12, and 13 correspondingly depend. As such, it is respectfully submitted that the combination does not disclose or suggest the invention recited in claims 2, 7, 12, and 13.

In the Office Action at pages 11-12, the Examiner reject claim 28 under 35 U.S.C. §103 in view of Fukuda et al., Katayama and Moriyama et al. The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's combination is correct, the Examiner does not rely upon Katayama and Moriyama et al. as curing the above noted deficiency of Fukuda et al. as applied to claim 16, from which claim 28 depends. As such, it is respectfully submitted

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that the combination does not disclose or suggest the invention recited in claim 28.

**STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION**

On page 3 of the Office Action, the Examiner states that claims 10 and 24 are allowed, and objects to claim 23 as depending from a rejected claim. Claim 23 has been made independent and has not been amended to narrow the scope of the claims.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,  
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on Nov 1, 2004  
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